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| 10/580,218 | 05/22/2006 | Francisco Casas Salva | MDR-0057 | 1853 |
| 34610 7590 02/19/2008 KED & ASSOCIATES, LLP P.O. Box 221200 Chantilly, VA 20153-1200 | | | | |
| EXAMINER | | | | |
| CLEMENT, MICHELLE RENEE | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/580,218

Applicant(s)

CASAS SALVA, FRANCISCO

Examiner

Michelle (Shelley) Clement

Art Unit

3641

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12-21, 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S508)
- Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection as necessitated by applicant's amendments.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 12-21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite in that it is not clear whether applicant intends the sporting rifle comprising screws to be encompassed by the claims. The claims initially recite the protective cover **for** (i.e. intended to be used with) a sporting rifle without positively reciting the sporting rifle but later recite the protective cover interacting with the sporting rifle. It is not clear what is intended to be included or excluded by the claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 12-15, 17-19, 23-26, and 28-30 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Davis (US Patent # 5,048,215). Davis discloses a protective cover that can

be used for a sporting rifle that comprises screws which are used to fix a shell propulsion mechanism to a rifle support, the protective cover comprising:

A main body (reference 30) having a predetermined length and width corresponding to a length and width of an area to be covered on a rifle support, the area to be covered including heads of screws that fix a shell propulsion mechanism to a rifle support; and
A fixing device that fixes the main body to the area to be covered, wherein the fixing device comprises one or more (two) deformable protrusions configured (i.e. having the ability) to push-fit mate with one or more corresponding recesses (Figure 10) (elements 10 and 30 are fabricated from plastic and therefor inherently deformable).

The main body is configured in size and shape such that at least part of a perimeter portion thereof has the ability too mate with a recess formed on an exterior surface of a rifle support.

The protective cover comprising a positioning device configured (i.e. has the ability) to position the main body on a rifle support.

The positioning device comprises at least two projections on an interior face of the main body configured (i.e. has the ability) to fit into at least two blind orifices on a rifle support.

At least part of an exterior surface of the main body is smooth and can bear graphic printed information on the exterior surface (it is noted that the bearing of graphics is not required by the usage of the term "can" but is merely optional requiring only an ability to bear graphic printed information).

Davis discloses a sporting rifle (reference 12) comprising the protective cover and the rifle comprising a rifle support (reference 10), a shell propulsion mechanism (references 14, 16), and screws (reference 38) that fix the shell propulsion mechanism to the rifle support.

The [a] statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; "even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is

unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed projectile or the

Product by Process Claims, applicant is direct to MPEP § 2113 cited in the prior office action.

Therefore the shape of the cover being produced by a single piece obtained through the injection molding process is not pertinent in this instance to the patentability of this product claim.

6. Claims 12-19 and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Crisler (US Patent # 1.795.840). Crisler discloses a protective cover that can be used for a sporting rifle that comprises screws which are used to fix a shell propulsion mechanism to a rifle support, the protective cover comprising:

A main body (reference 12) having a predetermined length and width corresponding to a length and width of an area to be covered on a rifle support (reference 15), the area to be covered including heads of screws (reference 16) that fix a shell propulsion mechanism to a rifle support; and

A fixing device that fixes the main body to the area to be covered, wherein the fixing device comprises one or more (two) deformable protrusions (reference 15) configured (i.e. having the ability) to push-fit mate with one or more corresponding recesses (references 14, 17) (element 12 is a soft resilient material preferably rubber and therefor inherently deformable).

The main body is configured in size and shape such that at least part of a perimeter portion thereof has the ability too mate with a recess formed on an exterior surface of a rifle support.

The protective cover comprising a positioning device configured (i.e. has the ability) to position the main body on a rifle support.

The positioning device comprises at least two projections on an interior face of the main body configured (i.e. has the ability) to fit into at least two blind orifices on a rifle support.

The protective cover is transversally convex towards an exterior and longitudinally elongated.

The deformable protrusions have a T shape (i.e. mushroom shape).

At least part of an exterior surface of the main body is smooth and can bear graphic printed information on the exterior surface (it is noted that the bearing of graphics is not required by the usage of the term "can" but is merely optional requiring only an ability to bear graphic printed information).

The [a) statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"] clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re* Pearson, 181 USPQ 641; *In re* Yanush, 177 USPQ 705; *In re* Finsterwalder, 168 USPQ 530; *In re* Casey, 512 USPQ 235; *In re* Otto, 136 USPQ 458; *Ex parte* Masham, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte* Masham, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re* Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed projectile or the **Product by Process** Claims, applicant is direct to MPEP § 2113 cited in the prior office action. Therefore the shape of the cover being produced by a single piece obtained through the injection molding process is not pertinent in this instance to the patentability of this product claim.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 12-20 and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rickenbacher (US Patent # 2,308,627) in view of Leek et al. (US Patent # 3,023,527). Rickenbacher discloses a protective cover that can be used for a sporting rifle that comprises

screws which are used to fix a shell propulsion mechanism to a rifle support, the protective cover comprising:

A main body (reference 34 or 22) having a predetermined length and width corresponding to a length and width of an area to be covered on a firearm support (references 33 and 35), the area to be covered including heads of screws that fix a shell propulsion mechanism (reference 1) to a rifle support (references 33 and 35); and
A fixing device (references 10, 11, 14, 15, 16, 17, 18, 19, 26 and 27) that fixes the main body to the area to be covered, wherein the fixing device comprises one or more (two) deformable protrusions configured (i.e. having the ability) to push-fit mate with one or more corresponding recesses. The lugs (14, 15, 26 and 27) comprises teeth/notches (i.e. protrusions) that interact with the notches on the pin (18) (i.e. the area between the notches constitutes additional recesses) to rigidly anchor the pin with the lugs (page 2, lines 1-15).

The main body is configured in size and shape such that at least part of a perimeter portion thereof has the ability to mate with a recess formed on an exterior surface of a support (Figure 2).

The protective cover comprising a positioning device configured (i.e. has the ability) to position the main body on a support (Figures 3 & 4).

The positioning device comprises at least two projections on an interior face of the support configured (i.e. has the ability) to fit into at least two blind orifices on the main body.

The protective cover is transversally convex towards an exterior and longitudinally elongated (Figure 4).

At least part of an exterior surface of the main body is smooth and can bear graphic printed information on the exterior surface (it is noted that the bearing of graphics is not required by the usage of the term "can" but is merely optional requiring only an ability to bear graphic printed information and/or the exterior surface of the main body would be smooth prior to the graphic being applied).

Although Rickenbacher does not expressly disclose the protective cover in combination with a rifle/sporting rifle, Leek et al. does. Leek et al. teaches a rifle comprising a rifle support, a shell propulsion mechanism, screws that fix the shell propulsion mechanism to the rifle support and a protective cover configured to cover an area on the rifle support including heads of the screws. Because both Rickenbacher and Leek et al. teach protective covers for covering exposed heads of screws on firearms, it would have been obvious to one skilled in the art to substitute one known cover for the other to achieve the predictable results attaining an aesthetically appealing firearm.

Rickenbacher and Leek et al. disclose the claimed invention except for the support comprising the at least two projections to fit into blind orifices on the main body instead of the main body comprising at least two projections on an interior face to fit into at least two blind orifices on a support. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include the projections on the main body and the orifices on the support, since it has been held that a mere reversal of the essential

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working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167.

Rickenbacher and Leek et al. disclose the claimed invention except for the cover expressly comprising four deformable protrusions and a multiplicity of screws. It is noted that Rickenbacher shows a number of protrusions (Figure 3 &4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to include any number of protrusions, including four, and any number of screws, since it has been held that the mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

The [a] statements of intended use or field of use, b)"adapted to" or "adapted for" clauses, c) "wherein" clauses, or d) "whereby"]clauses are essentially method limitations or statements of intended or desired use. Thus, these claims as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647.

See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. *In re Danly*, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps; “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 227 USPQ 964. Regarding the process for making the claimed projectile or the **Product by Process** Claims, applicant is direct to MPEP § 2113 cited in the prior office action. Therefore the shape of the cover being produced by a single piece obtained through the injection molding process is not pertinent in this instance to the patentability of this product claim.

9. Claims 24, 30 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crisler (US Patent # 1,795,840) in view of Browning et al. (US Patent # 5,778,590). Crisler discloses a protective cover that can be used **for** a sporting rifle that comprises screws which are used to fix a shell propulsion mechanism to a rifle support, the protective cover comprising:

A main body (reference 12) having a predetermined length and width corresponding to a length and width of an area to be covered on a rifle support (reference 15), the area to be covered including heads of screws (reference 16) that fix a shell propulsion mechanism to a rifle support; and

A fixing device that fixes the main body to the area to be covered, wherein the fixing device comprises one or more (two) deformable protrusions (reference 15) configured (i.e. having the ability) to push-fit mate with one or more corresponding recesses

(references 14, 17) (element 12 is a soft resilient material preferably rubber and therefor inherently deformable). The deformable protrusions have a T (i.e. mushroom) shape.

Although Crisler does not expressly disclose a rifle, to which the butt would be attached, Browning et al. does. Browning discloses a rifle comprising a rifle support, and a shell propulsion mechanism. all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded predictable results to one of ordinary skill in the art at the time of the invention.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle (Shelley) Clement whose telephone number is 571.272.6884. The examiner can normally be reached on Monday thru Thursday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone can be reached on 571.272.6873. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michelle (Shelley) Clement/
Primary Examiner, Art Unit 3641